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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,446	09/05/2003	Steven K. Coulthard	16217-002001	8480
26181	7590	07/12/2005	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			LYLES IRVING, CARMEN V	
		ART UNIT		PAPER NUMBER
		1731		

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/656,446	COULTHARD, STEVEN K.
	Examiner	Art Unit
	Carmen Lyles-Irving	1731

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09/05/03, 01/28/05, and 04/01/05.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/03, 01/05 & 04/05</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks (U.S. Patent No. 6,463,936) in view of Walker (U.S. Patent No. 6,142,769). Regarding claim 1, Hicks teaches an apparatus for extinguishing and containing a cigarette, the apparatus comprising a container having an open end, a hollow interior having a substantially constant interior diameter, and a closed end, wherein the open end is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette; a clip including: a first portion grasping an exterior of the container; and a first and a second resilient arm, each arm extending from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm (Figure 5). Hicks fails to teach a bottle opener connected to the exterior of the container. However, Walker teaches that it is known to combine cigarette lighters with other devices, i.e., bottle openers; therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Hicks with the teaching of Walker in order for the user of the apparatus to accomplish a plurality of tasks with a single tool (Walker, column 1, lines 5-6). Accordingly, claim 1 is rejected.

Regarding claims 2 and 12, Walker teaches the container is a cylindrical container (Figure 1). Accordingly, claim 2 is rejected.

Regarding claims 3 and 13, Walker teaches a can tab opener connected to the exterior of the container (Figure 1, tip of reference number 42). Accordingly, claim 3 is rejected.

Regarding claims 4 and 14, Hicks teaches that the interior diameter of the container is such that a lit cigarette will lodge in the interior of the cylindrical container and self-extinguish (Figure 1; column 2, lines 7-10). Accordingly, claim 4 is rejected.

Regarding claim 5, Hicks fails to teach that the interior of the closed end of the container is a convex surface extending toward the open end. However, due to a lack of criticality and unexpected results, designing the container such that the interior of the closed end of the container is a convex surface extending toward the open end is a matter of design choice. Accordingly, claim 5 is rejected.

Regarding claims 6 and 15, Hicks teaches the container comprises a heat-resistant plastic (column 3, lines 30-31). Accordingly, claims 6 and 15 are rejected.

Regarding claim 8, Hicks fails to teach the container is connected to the clip by a snug-fit connection. However, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill in the art to connect the clip to the container by a number of different ways, include using a snug-fit connection. Accordingly, claim 8 is rejected.

Regarding claim 9, Hicks teaches the first portion of the clip includes two or more grooves (point where area bowed region 66 meets area indicated by 64 on each side of

container) on an exterior of the first portion (indicated by reference portion 64 in Figure 5) adapted to receive the fingers of a user of the apparatus. Accordingly, claim 9 is rejected.

Regarding claims 10 and 17, Walker teaches the apparatus may comprise a pen tip connected to the container (Figure 1, reference number 34) and a light connected to the container (Figure 2, reference number 44). Accordingly, claims 10 and 17 are rejected.

Regarding claim 11, Hicks teaches an apparatus for extinguishing and containing a cigarette, the apparatus comprising a container having: an open end, a hollow interior having a substantially constant interior diameter, and a closed end, wherein the open end is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette; a first and a second resilient arm, each arm extending from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm (Figure 5). Hicks fails to teach a bottle opener connected to the exterior of the container. However, Walker teaches that it is known to combine cigarette lighters with other devices, i.e., bottle openers; therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Hicks with the teaching of Walker in order for the user of the apparatus to accomplish a plurality of tasks with a single tool (Walker, column 1, lines 5-6). Accordingly, claim 11 is rejected.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks as applied to claim 1 above, and further in view of Hawley's Condensed Chemical

Dictionary (pgs. 3 and 1097). Hicks teaches that the container is made from a heat-resistant plastic (column 3, lines 30-31). Hicks fails to teach that the clip is made from a heat-resistant plastic. Hicks also fails to teach that the container and the clip comprise a glass filled ABS plastic. Hawley's Condensed Chemical Dictionary teaches that ABS resins or plastics are any of a group of tough, rigid thermoplastics (pg. 3).

Thermoplastics are high polymers that soften when exposed to heat and return to their original condition when cooled to room temperature (pg. 1097). They are heat-resistant. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Hicks with the teaching of Hawley's Condensed Chemical Dictionary making the container and the clip of the apparatus from an ABS plastic, specifically a glass filled ABS plastic, because such plastics are heat resistant and could withstand being exposed lit cigarettes. Accordingly, claims 7 and 16 are rejected.

Conclusion

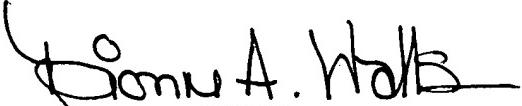
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen Lyles-Irving whose telephone number is (571) 272-2945. The examiner can normally be reached Monday through Friday from 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLI
07/10/05


DIONNE A. WALLS
PRIMARY EXAMINER